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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941.

No. 720.

MILCOR STEEL COMPANY,
Petitioner,

vs.

GEORGE A. FULLER COMPANY, NEFF LATHING COMPANY, INC., and CONVER STEEL & WIRE COMPANY, INC.,
Respondents.

BRIEF FOR PETITIONER.

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BRIEF FOR PETITIONER.

Opinions of the Courts Below.

The opinion of the United States District Court for the Southern District of New York was filed December 2, 1940 (R. 28), and judgment was entered pursuant thereto (R. 28) on December 18, 1940. The opinion has not been reported.

The opinion of the Court of Appeals for the Second Circuit (R. 108) was filed July 31, 1941, and is reported in 122 F. 2d 292. Judgment was entered in accordance with the opinion on August 21, 1941 (R. 113).

Concrete Statement of Jurisdiction.

1. This is a suit arising under the patent laws of the United States, Judicial Code, Sec. 24 (7) (28 U. S. C. Sec. 41 (7)).

2. The jurisdiction of this Court is invoked under Sec. 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347).

Statement of the Case.

This is a suit brought by Petitioner against Respondents for infringement and contributory infringement of Petitioner's Holdsworth patent No. 2,105,770, issued January 18, 1938, for Wall Construction (R. 30). The complaint (R. 2) was filed on June 22, 1939. On November 29, 1939, Petitioner advised Respondents' attorneys (R. 10) that a disclaimer (R. 10) had been filed in the United States Patent Office as to the claims at issue, namely, Claims 6 and 7 of the Holdsworth patent in suit.

On October 8, 1940, a motion (R. 13) was filed on behalf of the Respondents for a judgment on the pleadings under Rule 12(c), or an alternative, for a summary judgment under Rule 56, of the Rules of Civil Procedure for the District Courts of the United States. On December 2, 1940, the District Court filed an opinion (R. 28), holding that the disclaimer as to Claims 6 and 7 of Petitioner's patent rendered the said claims invalid in view of the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, and thereafter on December 18, 1940, a judgment (R. 28) was entered pursuant to the said opinion, dismissing the complaint on the ground that Claims 6 and 7 of the patent in suit were invalid and void by reason of improper disclaimer.

An appeal was duly taken by Petitioner to the United States Circuit Court of Appeals for the Second Circuit, and on July 31, 1941, the said Court affirmed the judgment of the District Court (R. 108), although recognizing that in doing so it was in conflict with the Circuit Courts of Appeals for the Sixth, Seventh and Ninth Circuits in its interpretation and application of the said decision of this Court in the said *Altoona* decision.

On October 27, 1941, Petitioner filed in this Court a petition for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit, presenting the following questions:

1. Is the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, correctly interpreted and applied in the instant case, or in the judgments in conflict therewith of the Circuit Courts of Appeals for the Sixth, Seventh and Ninth Circuits?

2. Is the decision correct in holding that every disclaimer which does not surrender a whole claim, necessarily adds a new element, and hence is invalid?

3. Does the disclaimer statute (U. S. Rev. Stat. Sec. 4917; U. S. C. Title 35, Sec. 65) permit a patentee who "has claimed more than that of which he was the original and first inventor," to render his patent "valid for all that part which is truly and justly his own," by defining more specifically an element of the claimed structure, thereby relinquishing a broad invention, which he did not invent, and preserving a limited invention, which he did invent?

On December 8, 1941, this Court granted the petition for writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit (R. 113).

Specification of Errors.

The errors which Petitioner will urge are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding that the Disclaimer Statute (U. S. Rev. Stat. Sec. 4917; U. S. C. Title 35, Sec. 65) does not permit a patentee who "has claimed more than that of which he was the original and first inventor," to render his patent "valid for all that part which is truly and justly his own," by defining more specifically an element of the claimed structure, thereby relinquishing a broad invention, which he did not invent, and preserving a limited invention, which he did invent.

2. In holding that the disclaimer statute only permits the surrender of the entire claim, and does not permit the restriction of a broad claim by specifying that an element thereof comprises certain structural characteristics.

3. In departing from the interpretation, which has existed more than one hundred years, of the disclaimer statute, and under which limiting disclaimers have been made in hundreds of patents now in force.

4. In holding that a disclaimer adds a new element to a claim when it makes more specific an already present element.

5. In construing the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, differently from the construction which has been placed upon it by the Sixth, Seventh and Ninth Circuit Courts of Appeals, and several District Courts.

Summary of Argument.

1. The disclaimer statute "affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent" (*Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477), and should be liberally interpreted to accomplish its intended purpose. *Sessions* v. *Romadka*, 145 U. S. 29, 40; *O'Reilly* v. *Morse* (56 U. S.), 15 How. 61; *Triplett* v. *Lowell*, 299 U. S. 638, 645; *Payne Furnace & Supply Co.* v. *Williams-Wallace Co.*, 117 Fed. 2d 823, C. C. A. 9.

2. The disclaimer as to Claims 6 and 7 of the patent in suit (a) added no new elements to those originally present in said claims, and (b) did not transform "the patent originally for one combination . . . into a new and different one." (*Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477; *Byrne Mfg. Co.* v. *American Flange & Mfg. Co.*, 87 F. 2d 783, C. C. A. 6; *Cincinnati Rubber Mfg. Co.* v. *Stowe-Woodward, Inc.*, 111 F. 2d 239, C. C. A. 6; *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 F. 2d 937, C. C. A. 7; *Payne Furnace & Supply Co.* v. *Williams-Wallace Co.*, 117 F. 2d 823, C. C. A. 9.)

3. Prior to the judgment of the Court of Appeals for the Second Circuit in the instant case, the disclaimer statute never has been limited to the elimination of entire claims, but disclaimers repeatedly have been sustained as valid which so restricted broad claims as to exclude that of which the patentee was not the inventor. (*Silsby et al.* v. *Foote*, 61 U. S. 378; *Hurlbut* v. *Schillinger*, 130 U. S. 456, 465; *Minerals Separation* v. *Butte & Superior Mining Co.*, 250 U. S. 336.)

4. *Stare decisis.* The judgment of the Court of Appeals for the Second Circuit will destroy property rights in hundreds of patents now in force which have been restricted by disclaimers made in good faith pursuant to an interpretation which has existed more than a hundred years of the disclaimer statute.

Argument.

U. S. Rev. Stat. Sec. 4917 (U. S. C. Title 35, Sec. 65), pursuant to which the disclaimer was filed by Petitioner, reads as follows:

> "Whenever, through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, *a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented;* and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it." (Italics ours.)

Sec. 4922 (U. S. C., Title 35, Sec. 71) supplements the foregoing statute by providing that a patentee may maintain a suit at law or equity for the infringement of any part of his patent which was *bona fide* his own, but "no

Jan. 18, 1938. H. HOLDSWORTH 2,105,770

WALL CONSTRUCTION

Filed Oct. 15, 1936

Fig. 1.

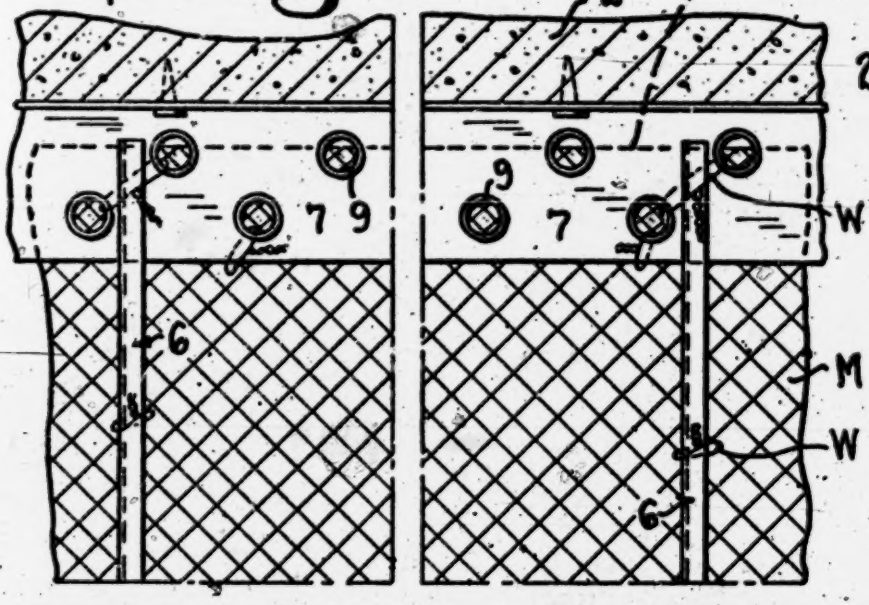
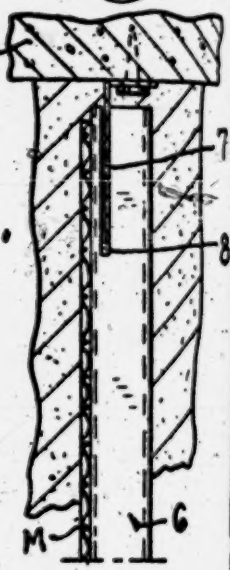


Fig. 2.



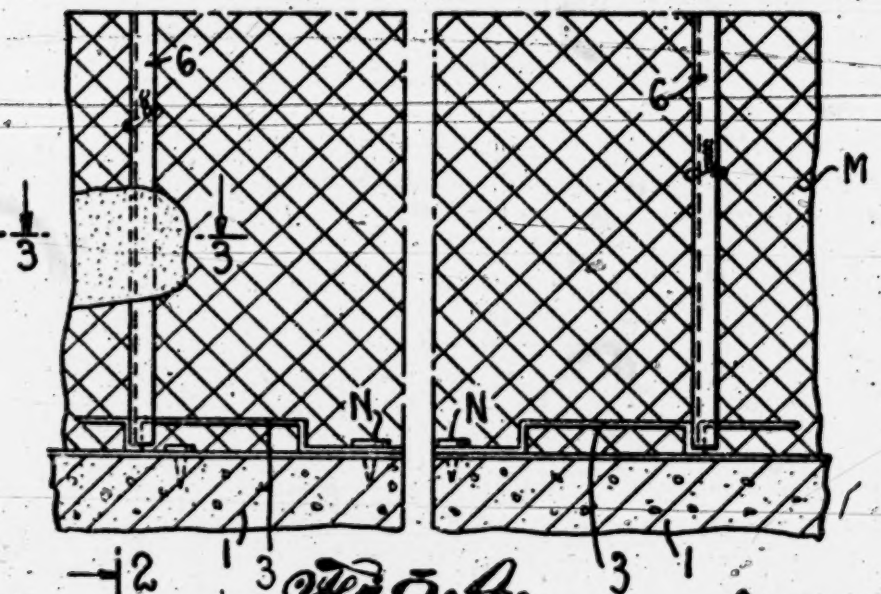
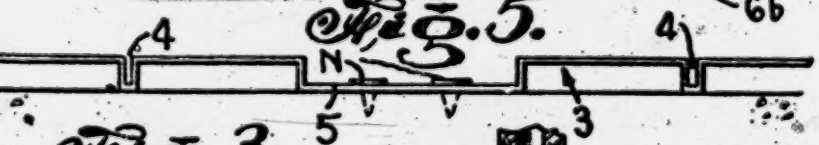


Fig. 4.

Fig. 5.



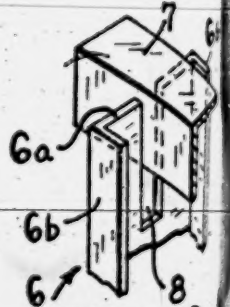


Fig. 6.

Fig. 3.

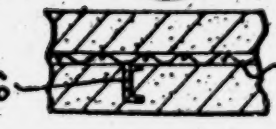
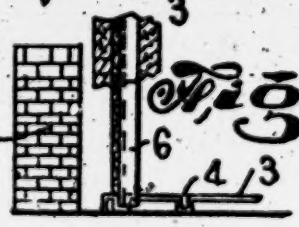


Fig. 7.



INVENTOR
Harry Holdsworth
BY
Mock & Blum
ATTORNEYS

costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit."

The above quoted and referred to disclaimer statutes have been frequently considered by this Court and their provisions compared (*Hailes* v. *Albany*, 123 U. S. 582, 588; *Sessions* v. *Romadka*, 145 U. S. 29; *Ensten* v. *Simon, Asher & Co.*, 282 U. S. 445, 452).

That the Holdsworth patent in suit illustrates and describes an invention patentable over the prior art; that Holdsworth was the first to render available to the public the practical and advantageous wall construction fully disclosed in the patent, and that Respondents have appropriated the said invention, are not challenged at this status of the litigation.

The only issue before the Court is whether Petitioner has constructively abandoned to the public that for which Holdsworth was "the original or first inventor or discoverer" by filing a disclaimer eliminating from the patent that of which Holdsworth was not the first inventor but had mistakenly included in the patent, without fraudulent or deceptive intention.

Holdsworth Patent in Suit (R. 30).

For convenient reference, the drawing of the patent in suit is here reproduced.

The specification (R. 31) states that the objects of the invention are to provide "an improved construction which can be used for constructing interior walls or partitions between rooms or which can also be used for constructing the furring of the exterior wall of a building"; "improved means for supporting metal lath or the like, for serving as a support for the plaster"; "a construction whereby the channels or other supporting members are held at their base against movement in any direction, and the upper ends of said channels or other supporting members are held so as to limit a turning movement in a direction parallel to the front or main wall of the channel," and "a structure which could be readily installed at minimum cost."

A base member 3 provided with spaced depressions 4 is suitably connected to the top surface of the floor 1. A ceiling member 7 of angular shape, having a perforated depending flange, is secured to the ceiling of the room in vertical alignment with the base 3. Vertical channel-shaped wall supports 6 are supported at their lower ends in the recesses 4 in the base member 3, and are provided with vertical slots 8 at their upper ends to receive the depending perforated flange of the ceiling member 7. The wall supports 6 are of slightly less height than the distance between the floor and ceiling of the room so that when the slots 8 therein are engaged with the depending flange of the ceiling member, said supports 6 may be moved vertically downwardly a sufficient distance to engage their lower ends with the recesses in the base member 3. The upper ends of the wall supports 6 extend between adjacent perforations in the depending flange of the ceiling member, and are prevented from longitudinal movement by the burrs around the perforations. The lower ends of the wall supports 6 are securely retained against movement relative to the

base member 3 through the engagement of the web of the channel members in the recesses in the base member with their flanges, or side walls, snugly abutting the side surfaces of the base member adjacent the recesses therein.

After the base member 3 and the ceiling member 7 have been secured in vertical alignment to the floor and ceiling respectively, the wall supports 6 are readily placed in position by engaging the slots 8 in their upper ends with the depending flange of the ceiling member 7 between adjacent perforations thereof, and then elevating said supports slightly so that the lower ends of their ends 6*a* are in position to drop into the recesses 4 in the base member. Any suitable metal lathing M may be secured to the wall supports 6, with its upper edge lapping the depending flange of the ceiling member 7, and plaster is then applied to the lathing.

Mr. William B. Turner, an expert in the art of wall construction for forming partitions and furring in buildings, fully set forth in his affidavit (R. 23) the practical advantages of the wall construction covered by the Holdsworth patent in suit and the objections which it overcomes in the previously known and used wall constructions for supporting metal lathing and plaster. The practicability of the wall construction covered by the patent in suit and its advantages over previous wall constructions, is evidenced by the erection by the Respondents in the Red Hook Housing Project of the infringing wall construction. The novelty of the Holdsworth patented wall construction is obvious when the Respondents have found it necessary to rely upon thirty-five prior patents (R. 8, 11, 12) to support their defense of anticipation.

The invention of the Holdsworth patent in suit as clearly stated in the specification and defined in Claims 6 and 7, resides in "a wall construction for a room," comprising readily assembled elements to which may be securely at-

tached lathing for supporting plaster. The lathing and the plaster are necessary parts of the completed wall, but the Holdsworth invention is not a wall but a construction for use in erecting walls. Walls comprising lathing and plaster supported thereon were not novel with Holdsworth, but his invention resided in a new construction upon which could be effectively built a complete wall comprising lathing and plaster.

1.

The disclaimer statute "affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent" (Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477), and should be liberally interpreted to accomplish its intended purpose.

Prior to 1832, the patent statute did not provide any statutory means whereby an original patent could be surrendered and replaced by a reissued patent, in order to correct errors in the original patent.

However, and as appears from the case of *Grant* v. *Raymond*, 31 U. S. 218 (1832), this Court sustained the validity of a reissued patent which had been granted in 1825, to replace an original patent which had been issued in 1821, as justified by the spirit of the law.

This Court stated (p. 240):

> "If the new patent can be sustained, it must be on the general spirit and object of the law, not on his letter."
>
> "That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake" (p. 242).

This Court then discussed the effect of the reissued patent upon infringers of the original patent.

"The new patent would retroact on them, and expose them to penalties to which they were not liable when the act was committed. This objection is more formidable in appearance than in reality. It is not probable, that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention; they are not entitled to much favor. . . . this defense is not made in this case. . . . The defence, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent" (p. 243).

It is stated in *Walker on Patents,* Deller Edition, Sec. 301,

"In accordance with the spirit of the decision in *Grant* v. *Raymond,* 6 Peters [31 U. S. 218, 8 L. Ed. 376 (1832), and within a few months after that decision was made, Congress enacted a statute to regulate the granting of reissued patents. (4 Statutes at Large, Chapter 162, Section 3, p. 559.)"

A similar provision for the reissue of a defective patent was contained in the United States Patent Act of 1836 (5 Stat. at large 117). It was not, however, until March, 1837, that a statute (5 Stat. at large, 91, Sec. 7) was enacted permitting a patentee who had inadvertently claimed more than he had invented, to preserve his patent for that which he had invented, by disclaiming that which he had not invented but which was inadvertently covered by his patent. The disclaimer statute therefore afforded new and additional means for curing a defective patent, which could only have been previously done by reissue and that only subsequent to 1832.

In order to obtain a reissue of an inoperative or invalid patent, it was (and is) necessary to surrender the original patent and to file an application for a reissue thereof, which involved expense and delay.

In addition, the reissued patent was effective only from the date of reissue, and the patentee lost his right to damages, for the period between the grant of the original

patent and the grant of the reissued patent. All right of action was suspended during the pendency of the application for reissue. (*Peck* v. *Collins*, 103 U. S. 660; *Moffitt* v. *Gaar*, 66 U. S. 273; *Robinson on Patents*, Secs. 696-699.)

Therefore the disclaimer provision of the statute, as added in 1837, was clearly intended to give a patentee a new and additional remedy, whereby he preserved the continuity of his patent right and his claim for damages.

Sec. 7 of the Act of 1837 stated in part:

> "That whenever any patentee shall have through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, may make disclaimer of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or assignment. . . . And such disclaimer shall thereafter be taken and considered as part of the original specification. . . . But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same."

In preserving the continuity of a patent and an infringement suit by means of disclaimer, the Congress was evidently influenced by the statement in *Grant* v. *Raymond* (*supra*), as to pirates who appropriated an invention because the patentee had claimed too much.

The evident purpose of ingrafting the equitable principle of disclaimer into the Patent Statute was to permit an immediate reformation of the original patent, in order to hold an infringer who had appropriated the invention.

Regarding the disclaimer statute, *Robinson on Patents*, Vol. 2, Par. 641 on page 280 states:

> ". . . It prejudices no one except him who relin-

quishes what he has hitherto asserted, and may be made by any owner of a separate interest in a patent without affecting the privileges of his co-owners or the public. Hence in the act of 1837 it was provided that this particular amendment might be made by any owner of the whole patent, or of a sectional interest therein, by filing in the Patent Office a written disclaimer of the excess, and that as modified by this disclaimer, the original patent should thereafter be construed in all cases where the rights of the disclaimant were involved. A disclaimer is thus an inexpensive and expeditious method of removing from a patent a defect which could at first be cured only by a reissue, and which may still be remedied at the option of the owners of the entire patent by that more elaborate proceeding."

This Court in *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445, 452, in reviewing the disclaimer statute said:

"Under the early accepted general rule a patent with an invalid claim was wholly void, and this defect effectually barred suit upon it. Congress undertook to modify this by §§ 7 and 9, Chap. 45, Act. of 1837. 5 Stat. 193. In substance these became §§ 4917 and 4922, Revised Statutes, and 65 and 71, Title 35, U. S. C. The two sections 'are parts of one law, having one general purpose, and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it.' *Hailes* v. *Albany Stove Co.*, 123 U. S. 582; *Sessions* v. *Romadka*, 145 U. S. 29, 41."

. . . . . .

"The statute is remedial; the intent is to aid the inventor free from wilful default or intention to mislead the public by permitting him to avoid the consequence of inadvertence, accident or mistake through prompt disavowal of the apparent right to exclude others from something improperly included in the words of his grant."

It has frequently been held that the disclaimer statute

is remedial and is in the interest of the public as well as of the inventor. In *O'Reilly* v. *Morse,* 56 U. S. 61, this Court in considering the subject of disclaimers in connection with the telegraphy invention of Morse said:

> "The law which requires and permits him to disclaim, is not penal but remedial."

In *Sessions* v. *Romadka,* 145 U. S. 29, 40, this Court stated:

> "The power to disclaim is a beneficial one, and ought not to be denied, except where it is resorted to for a fraudulent and deceptive purpose."

In *Triplett* v. *Lowell,* 297 U. S. 638, 645, this Court said:

> "The disclaimer statute is remedial, and intended for the protection of both the patentee and the public."

2.

The disclaimer as to Claims 6 and 7 of the patent in suit (a) added no new elements to those originally present in said claims, and (b) did not transform "the patent originally for one combination . . . into a new and different one."

Petitioner, believing that Holdsworth had "claimed more than that of which he was the original or first inventor or discoverer," in order that the patent should "be valid for all that part which is truly and justly his (Holdsworth's) own," availed itself of its statutory right and filed a disclaimer "of such parts of the thing patented" as it did "not choose to hold by virtue of the patent."

Original Claims 6 and 7 were generic to a wall construction comprising the elements disclosed in the patent as the preferred embodiment of the invention, and Petitioner, feeling that Holdsworth was not the first inventor of such generic invention, disclaimed all species under that genus except such species as comprised the elements of the origi-

nal claims but which possessed certain specific characteristics.

The disclaimer as to Claim 6 reads as follows:

> "As to claim 6, except a wall construction for a room in which the ceiling member comprises a vertical depending perforated flange, one side of which is overlapped by metal lathing" (R. 34).

For convenient reference, Claim 6 is printed here with the limitation added by disclaimer italicized:

> "6. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member *comprising a vertical depending perforated flange, one side of which is overlapped by metal lathing,* said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, and means operative to prevent any substantial tilting movement of said wall supports from their predetermined upstanding position" (R. 33).

Claim 6, originally, and as limited by the disclaimer, defines a wall construction comprising certain specified elements, namely, a base member, a ceiling member, upstanding wall supports, and means operative to prevent substantial tilting movement of the wall supports from their predetermined upstanding position, and defines their structural characteristics and their cooperative relationship.

The disclaimer limits or restricts the "ceiling member" by specifying that it comprises "a vertical depending perforated flange, one side of which is overlapped by metal lathing." The disclaimer does not add metal lathing as a new physical element to the combination claimed, but

merely refers to it in connection with the already present element, "ceiling member," to limit the same to one which comprises a vertical depending perforated flange, having the characteristic of being overlapped by metal lathing.

The specification and drawing of the Holdsworth patent disclose the wall construction embodying the invention as comprising a ceiling member having a vertically depending perforated flange (page 1, line 35 *et seq.*), which is overlapped by the metal lathing (page 2, line 33 *et seq.*). Consequently, Claim 6 as limited by the disclaimer is for the same combination previously claimed, and is not transformed into a new and different combination.

The drawings and description of the Holdsworth patent disclose only a single embodiment of the invention, in which the "ceiling member" has the shape and relation to the metal lathing, specified in the disclaimer. The more specific description of the ceiling member did not add a new mechanical element. On the contrary, it made more specific a mechanical element already in the claim. For example, let us assume that the first man who originated a knife which had a blade and a handle had secured a patent thereon, and that the drawings showed and the specification stated that the blade had a point. If the claim broadly specified the combination of a blade and a handle, it would not be adding a new mechanical element to state, by way of disclaimer, that the blade was shaped so as to have a point.

The disclaimer as to Claim 7 is as follows:

> "As to claim 7, except a wall construction for a room in which the base member is composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base member adjacent the recesses" (R. 34).

For convenient reference, Claim 7 is printed here with the limitation added by disclaimer italicized:

"7. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member, said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, said base member *composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base member adjacent the recesses,* and said ceiling member being shaped to provide means which are operative to prevent any substantial tilting of said wall supports from their predetermined upstanding position" (R. 33).

The base member, which is an element of Claim 7 in its original form, is more specifically defined by the disclaimer as "composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports," and the shape of the wall supports, which are an element of Claim 7 in its original form, are specifically defined as of channel form, the flanges of which overlap the base member adjacent the recesses therein.

The drawings and specification explicitly describe the invention of Holdsworth as residing in a wall construction comprising a base member and channel wall supports having the characteristics to which they are limited by the disclaimer (page 1, line 10 *et seq.*)

Judgment of Lower Courts.

The District Court in granting the motion of the Respondents for a summary judgment and dismissing the bill of complaint on the ground that the disclaimer rendered Claims 6 and 7, to which it was directed, invalid said (R. 28):

> "Confronted, as I am, with the decision of the Supreme Court in *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477, I see no escape from the necessity of granting defendants' summary judgment upon the pleadings. Clearly, I think, plaintiff's disclaimers as respects Claims 6 and 7 imported into them elements that were excluded by their language prior to its revision. For this reason, the claims are now invalid and must fall."

The Court of Appeals in affirming the judgment of the District Court said (R. 112):

> ". . . But the *Altoona* case cannot by any reasoning be reconciled with the validity of the practice, in spite of certain passages in the opinion on which the plaintiff here relies. The disclaimers added the fly-wheel as a new element; as we have seen, every disclaimer of this type must add a new element, and the court held the claims bad only because the disclaimers did just that."

Petitioner submits that a consideration of the facts before this Court in the *Altoona* case clearly shows that this Court neither in spirit, nor in letter, held that a disclaimer, such as that in the instant case, was not warranted by the disclaimer statute. This Court in its opinion said:

> "While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in Claims 9 and 13 only when used in conjunction with a flywheel, it also *operated to add the flywheel as a new element to each of the combinations described in the claims.*"

". . . While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, *whereby the patent originally for one combination is transformed into a new and different one for the new combination.*" (Emphasis supplied.)

That the disclaimer clearly added a flywheel as a new element to those included in original Claims 9 and 13 appears from a consideration of such claims. Claim 13, for instance, read as follows:

"13. An apparatus for reproducing speech, music or the like sounds from vibrations recorded on a film, by the use of a line of light varied in accordance with the sound, comprising a photoelectric cell, means for imparting to the film a rapid and uniform motion longitudinally of the film past said cell, a source of light projection for providing said light, and an objective lens in the path of said light and spaced from the film for directing said light as a converging narrow line impinging on the film at a point in the region of the focal point of said lens, said light passing through the film and on to said cell, the space between said lens and the film being free of obstructions to said light."

The following disclaimer was made as to said claim:

"The combination as set forth in claim 13, except wherein a flywheel is operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film."

Original Claim 13 included as an element "means for imparting to the film a rapid and uniform motion longitudinally of the film past said cell," and the disclaimer did not make more specific the said element but added as a new element the flywheel "operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film." The flywheel therefore by disclaimer was introduced in the claim as an element in addition to

the means in the original claim for imparting uniformity of motion to the film.

The decision of this Court in the *Altoona* case very clearly did not hold that a disclaimer which merely specified that an element present in an original claim possessed certain specific characteristics, was invalid, but only held that a new element could not be added by disclaimer to the elements already present in an original claim if by the addition of such new element "the patent originally for one combination is transformed into a new and different one for the new combination."

In order to invalidate a patent, the disclaimer must fulfill both of two conditions, as distinguished from either of said conditions, namely, a new element must be added, and the addition of the new element must also transform an original combination into a new and different combination.

As we have heretofore pointed out, the disclaimer to Claims 6 and 7 of the Holdsworth patent not only did not add new elements to those already present in the said claims, but did not transform the patent originally for one combination into a new and different one for the new combination. The disclaimers merely rendered Claims 6 and 7 less generic and more specific to the only embodiment of the invention disclosed in the patent. The disclaimers therefore are such as this Court, in the note at the bottom of page 490 of the *Altoona* decision, held as having been approved, namely "by limiting the claim to a specific type of the general class to which it was applied."

The decision of this Court in the *Altoona* case has been considered by the Courts of Appeals in the Sixth, Seventh and Ninth Circuits, and has been construed as not rendering invalid disclaimers of the character of that in

Oct. 28, 1924.

1,513,637

M. SCHWARTZ

BUSHING

Filed Aug. 17, 1922

Fig. 1

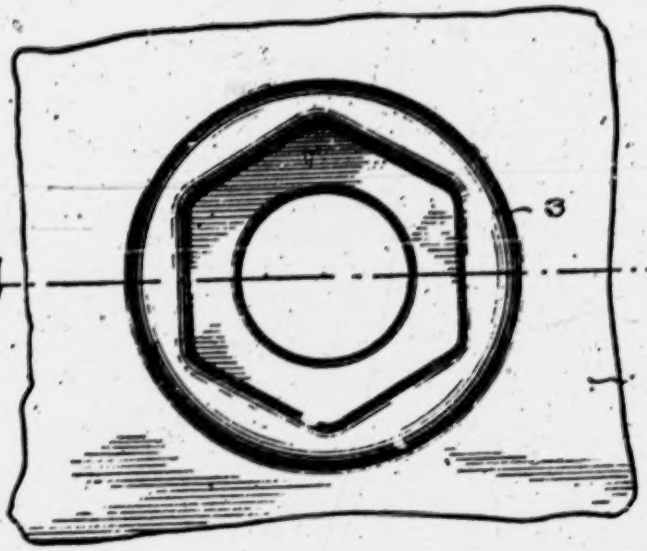


Fig. 2

Fig. 3

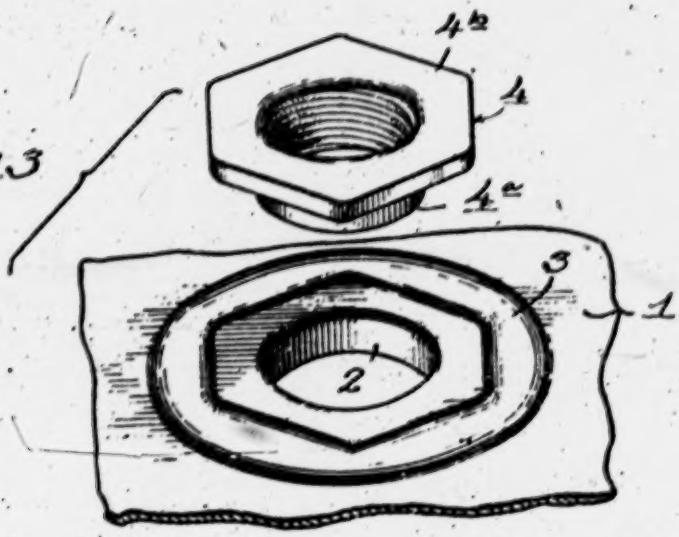
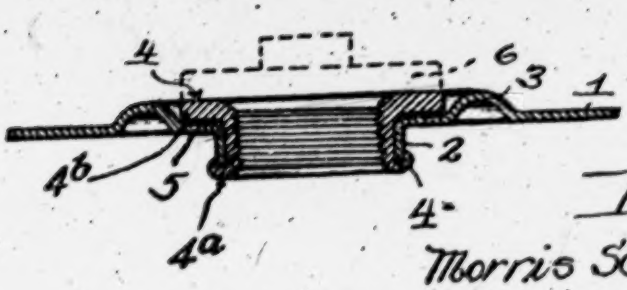


Fig. 4



Inventor,
Morris Schwartz,
By Offield Kobb Hunton & Scott. Attys.

the instant case, and with which decisions the Circuit Court of Appeals for the Second Circuit admittedly disagreed (R. 112-3).

The Court of Appeals for the Sixth Circuit in *Byrne Mfg. Co.* v. *American Flange & Mfg. Co., Inc.*, 87 F. 2d 783, decided January 12, 1937, had before it a patent to Schwartz, No. 1,513,637 for a Bushing, as to Claims 1 and 3 of which a disclaimer had been filed very similar to that filed as to Claims 6 and 7 of the Holdsworth patent. For convenient reference, we here reproduce the drawing of the said Schwartz patent.

The Schwartz invention relates to an annular bushing for metal containers. 1 indicates a portion of the metal wall of the container, with a hole therein surrounded by an annular flange or collar 2. A bushing or bung ring 4, comprising an internally threaded cylindrical portion 4*a*, is inserted in the hole in the metal container, and the lower edge of the cylindrical portion 4*a* of the bushing is curled over the lower edge of the collar 2 around the hole in the container wall, thereby tightly securing the bushing in position and against rotation with respect to the container by reason of the hexagonal perimeter 4*b* of the bushing engaging with a similar seat formed in the wall of the container around the hole therethrough. Claims 1 and 3 of the Schwartz patent, together with the disclaimer relating to them, appear in 87 F. 2d 784.

The disclaimer limited the support of Claim 1 to "a metal container having a hole in which the bushing is sealed by rolling the marginal portion of the bushing over, upon and around the edge of the annular flange surrounding the hole." The support, as well as the bushing, elements of original Claim 1, were respectively limited by the disclaimer to a metal container having an annular flange around the hole therethrough, and to a bushing having a

marginal portion rolled around the edge of the annular flange surrounding the hole.

If the disclaimer herein is objected to, on the ground that it adds one or more additional elements to the claims, such objection applies with even greater force to the disclaimer to the Schwartz patent, because such disclaimer incorporated a reference to the rolled marginal portion of the bushing, and the association between this rolled marginal portion and the annular flange surrounding the hole.

The disclaimer to Claim 3 of the Schwartz patent limited the method covered thereby to one in which the step for sealing the ring within the hole in the metal container, comprised "rolling the marginal portion of the ring over, upon and around the edge of the angularly projecting annular flange surrounding the hole."

The record in the said case shows that the defendant attacked the validity of Claims 1 and 3 of the Schwartz patent on the ground that the disclaimer was improper in view of the previously rendered decision of this Court in the *Altoona* case. The Court of Appeals for the Sixth Circuit, however, in sustaining the claims as valid, said:

> "It is urged that this disclaimer enlarges the scope of claims 1 and 3 of Schwartz and is therefore invalid. We think otherwise. The disclaimer adds no new element. The effect of it as to claim 1 is to limit the engagement between the perimeter of the laterally projecting flange of the bushing and its seat to certain characteristics; and as to claim 3, to limit the sealing step of the bushing to the process of rolling the inner edge thereof, under, around, and over the edge of the annular collar surrounding the hole. See *Wood* v. *Peerless Motor Car Corp.*, 75 F. (2d) 554, 556 (C. C. A.-6); *N. O. Nelson Mfg. Co.* v. *F. E. Meyers & Bro. Co.*, 29 F. (2d) 968, 969 (C. C. A. 6)" (p. 784).

The Court of Appeals for the Sixth Circuit in a later case, *Cincinnati Rubber Mfg Co.* v. *Stowe-Woodward, Inc.*, 111 F. (2d) 239, held valid certain claims as to which a

disclaimer had been filed and which the defendant contended were rendered invalid thereby. The disclaimer as to Claim 1 of the Woodward reissue patent No. 18,111 there in suit will serve to illustrate that the court held valid a disclaimer similar to the disclaimer to Claims 6 and 7 of the Holdsworth patent in suit. Claim 1, which appears on page 241, 111 F. 2d, reads as follows:

> "A roll comprising pieces of rock forming a portion of the active surface of the roll; and a binder of material other than said rock for holding said pieces in the desired position."

The disclaimer as to Claim 1 and other claims appears on page 242, and reads as follows:

> "Under claims 1, 2, 3, 4, 5, 6 and 8 it disclaims from the scope of said claims all rolls, if such be in law comprehended by said claims in their present form, other than paper machine rolls for operation in contact with a moist web."

In holding valid the claims as limited by the disclaimer, the Court said:

> "The disclaimer of the words 'and elsewhere' confined the patent to paper making machines. As applied to the claims, the disclaimer limited them to rolls in a paper making machine which came 'in contact with a moist web.'
>
> "A disclaimer that limits claims by exclusion of a part to a field they might in their original form have covered, is proper. *Byrne Mfg. Co.* v. *American Flange & Mfg. Co.*, 6 Cir., 87 F. 2d 783, 784, and cases there cited."

It will be seen that the roll, an element of original Claim 1, was limited by the disclaimer to "paper machine rolls," and its operation was limited by the disclaimer to contacting "with a moist web." The disclaimer of course did not incorporate in original Claim 1 a moist web as an element, but merely referred thereto in specifically limiting the field of operation of the roll to one where the roll contacted with a moist web.

Therefore, when the disclaimer to Claim 6 herein (*supra*, page 15) refers to the contact of the vertical depending perforated flange with metal lathing, this strictly follows the practice which was approved in the above decision.

The said opinion of the Court of Appeals for the Sixth Circuit was rendered on April 12, 1940, more than five years after the decision of this Court in the *Altoona* case.

The Court of Appeals for the Seventh Circuit in *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 F. (2d) 937, in holding valid claims of the Polydorff patent No. 1,982,690, as to which a disclaimer had been filed, reviewed the law and stated:

> "We think the disclaimer is within the statute, that it adds no new elements, that it diminishes the scope of the claims of the patent without prejudicing the rights of anyone. *Byrne Mfg. Co.* v. *American Flange & Mfg. Co., Inc.*, 6 Cir., 87 F. 2d 783; *Dunbar* v. *Meyers*, 94 U. S. 187, 24 L. Ed. 34; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 55 S. Ct. 455, 79 L. Ed. 1005. Consequently we shall consider the claims as limited by the disclaimer."

The claims of the Polydoroff patent with the disclaimers thereto printed in italics, appear in the footnote on page 944. Claim 1, as an example, is quoted below, in which the matter entered by disclaimer is italicized:

> "1. A compressed comminuted magnetic material having (a) individually-insulated particles and (b) a substantially constant permeability for a band of radio frequencies at least one octave wide. (c) *substantially all of the particles are capable of passing through a screen having 400 meshes to the inch (d) the compressed material has an apparent permeability of not less than 7, (1) at a frequency of from 300-1400 kilocycles*: (2) *at a magnetic intensity between 0.01 and 10 gauss (e) the compressed material has a resistivity of at least 10 ohms per centimeter cube.*"

Original Claim 1 broadly claimed a compressed com-

minuted magnetic material having individually insulated particles and a substantially constant permeability for a band of radio frequencies at least one octave wide. The disclaimer modified the claim by specifying that the particles were of a specified size and possessed various other characteristics.

The Court further stated (p. 945):

> "The record indicates that the Polydoroff claim was too broad and, as constituted, included many compositions that were old. Consequently, truly to represent his alleged invention, the patentee found it necessary to disclaim as to all such devices as were not within the specific limitations of his allegedly new teaching. In other words, if he taught anything it was the making of a core with the specific limitations appearing in the claim as affected by the disclaimer."

> "His description and specifications are long and in great detail, and from an examination thereof, we conclude that the claim was not broadened by the disclaimer; that each of the specified limitations brought about by the disclaimer was sufficiently described in the application of the patent as to be embodied in the claim after disclaimer, and that those limitations are consistent and in accord with the specifications and teachings of Polydoroff."

The Court, in rendering its opinion, cited as authorities the decision of this Court in the *Altoona* case and the decision of the Court of Appeals for the Sixth Circuit in the *Byrne Mfg. Co.* case, and hence construed the said decisions as contended for in the instant case on behalf of Petitioner, inasmuch as the disclaimer in the Polydoroff patent was similar to the disclaimer to Claims 6 and 7 of the Holdsworth patent.

The Court of Appeals for the Ninth Circuit in its recent decision in *Payne Furnace & Supply Co., Inc.* v. *Williams-Wallace Co.*, 117 F. (2d) 823, decided February 14, 1941, fully considered the law as to disclaimers, and par-

ticularly the decision of this Court in the *Altoona* case. The patent before the Court was No. 2,013,193 to Stadtfeld, granted September 3, 1935, for Composite Pipe Construction, as to Claims 1, 2 and 3 of which a disclaimer had been filed. In order to show the pertinency of this decision as supporting Petitioner's contention that the disclaimer in the instant case is valid and not in conflict with the law as stated by this Court in the *Altoona* case, and further to show its conflict with the decision of the Court in the instant case, we here present the drawings of the said Stadtfeld patent.

Claims 1, 2 and 3 of the Stadtfeld patent appear in the opinion (p. 825), Claim 1 of which may be taken as illustrative, reading as follows:

> "1. A composite pipe construction comprising an outer tube, one or more layers of insulating material located around the inside surface of the said tube, and an inner tube slidably located inside the insulating material."

The disclaimer filed as to said claim reads as follows (p. 826):

> "Hereby makes disclaimer of any combination of the recited elements in claims 1 and 2, except for 'composite' 'sectional' pipes for conducting 'fluids or gases of combustion' and except when 'adjacent ends of the inner and outer pipes of each section' have 'male and female' ends with the male 'end of the inner pipe' 'located adjacent the female end of the outer pipe,' and with the male end of an inner tube pointing downwardly and' adapted to be 'fitted inside the female end of the adjoining lower section' so that 'any condensates forming inside the said inner pipes are carried over the joint,' and 'with the male end of' the 'outer pipe of a section pointing upwardly and' adapted to be 'located inside the female end of the next higher pipe of another section,' so that 'a joint is provided which sheds any exterior moisture running downwardly over the outer pipes,' and the completed joints between 'adjacent ends' of adjoining sec-

COMPOSITE PIPE CONSTRUCTION

Filed Nov. 3, 1934

Fig. 1.

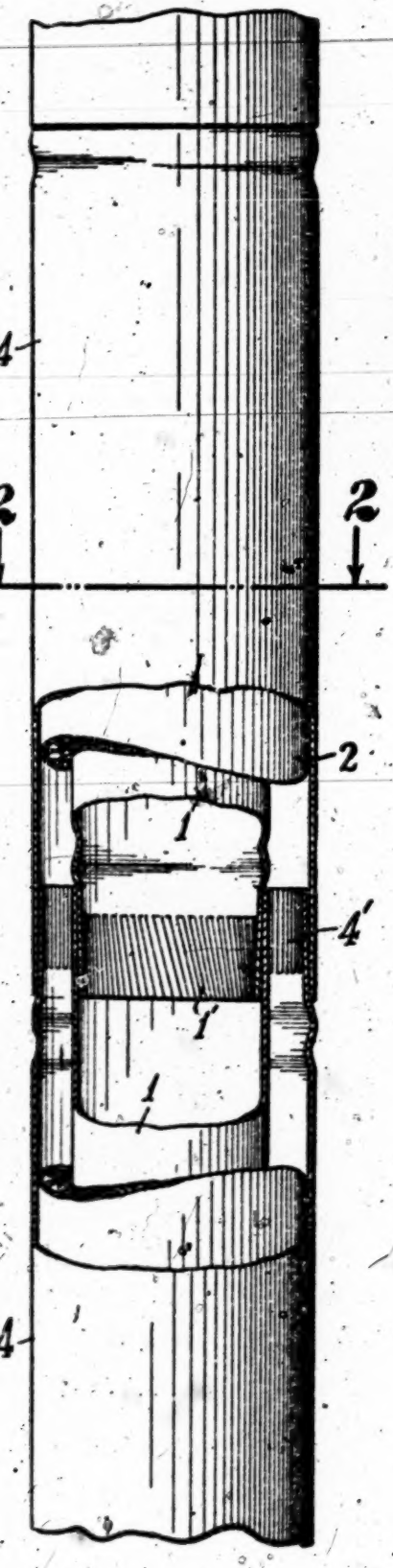


Fig. 2.

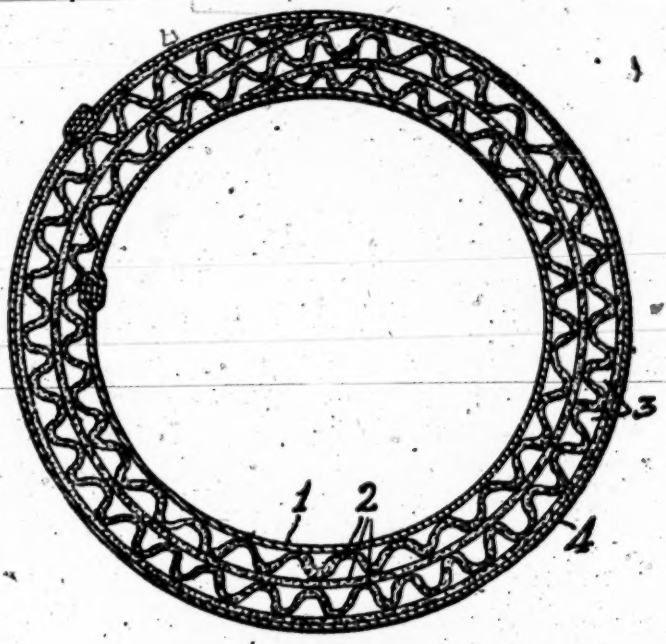
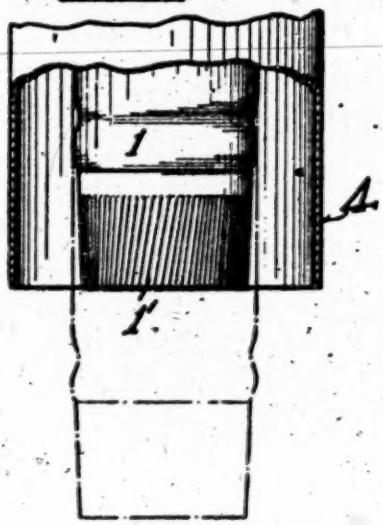


Fig. 3.



INVENTOR.
Jacob A. Stadtfeld
BY J. E. Traitteco
ATTORNEY

tions 'of the inner and outer pipes' are in substantial radial alignment, and except when each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship'; and except when the 'insulating material interposed between the two pipes' provides 'an intermediate filler' and 'has a plurality of air cells running longitudinally therethrough.' "

The facts before the Court of Appeals for the Ninth Circuit and the facts in the instant case were so analogous that the following quotations from the opinion of the said court are particularly pertinent (pp. 827, 828):

"Appellant leans heavily on the *Altoona Publix Theatres* decision. It contends that appellee's disclaimer attempts to import into the patent elements lacking in the original claims; and that the disclaimer is, and must of necessity be, predicated upon an admission that the combination originally claimed is invalid."

. . . . . .

"We do not understand that the Supreme Court in the *Altoona Publix Theatres* decision, *supra*, intended to overrule the many decisions upholding disclaimers of this character."

. . . . . .

"After the disclaimer, as before, the combination consists of three elements, plus the functional feature of slidability. These elements, however, as modified by the disclaimer, have certain structural characteristics or limitations not mentioned in the claims."

. . . . . .

"We are unable to read the disclaimer as attempting to do more than confine the claims to the specific environment already fixed in the specifications and drawings. By it the inventor undertakes to narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications."

Not only is the decision of this Court in the *Altoona* case construed by various Circuit Courts of Appeals consistently with the construction which Petitioner urges in

the instant case, and inconsistent with the decision of the lower court, but it has been similarly construed by various District Courts, including Judge Schoonmaker in *American Morgan Co.* v. *Joy Mfg. Co.*, 31 F. Supp. 419, 424. Judge Schoonmaker said:

> "The plaintiffs further urge the court to hold the claims of the Arentzen patent invalid, because the defendant has brought into his claims a new element, *i.e.*, a particular type of endless-chain conveyor, to wit, 'a single endless chain that extends around said decks so as to lie above and below the same in a plane substantially vertical thereto.' This, the plaintiffs claim, is adding a new element to the three claims in suit, which cannot be done, under the ruling of the Supreme Court in *Altoona Publix Theatres* v. *American Tri-Ergon Corp. et al.*, 294 U. S. 477, 490, 491, 55 S. Ct. 455, 79 L. Ed. 1005. However, we cannot see that defendant has introduced a new element by its disclaimer. The endless chain was in the original specification, and, by the disclaimer, is limited to a particular type of endless chain.
>
> "Plaintiffs also contend that the Arentzen patent is invalid, because the disclaimer defines a different invention than that of the original patent. We cannot find that the disclaimer in the instant case does that. As we view the disclaimer, it limits the claims in suit to a specific type of endless chain, thereby bringing the disclaimer within the class where a claim is limited to a specific type of the general class to which it was applied. See *Altoona Publix Theatres* v. *American Tri-Ergon Corp., supra.*"

To the same effect is the recent decision of Judge Chestnut in *Kilgore Mfg. Co.* v. *Triumph*, 37 F. Supp. 766, 770:

> "The language of the claim should of course be interpreted in the light of the specifications which in this case are helpful; and it should also be particularly noted that on September 23, 1931, the patentees entered a disclaimer restricting Claim 1 which reads as follows: 'By restricting the element "cartridge casing" of said Claim 1 to "closed at its rear end and capable of standing the strains of firing and eject-

ing completely a projectile therefrom without deformation of the 'cartridge casing.'" " "

"The defendant's counsel contends that the disclaimer is invalid because in reality it is an addition to rather than a limitation or restriction of the claim; but I do not so construe it. See *Altoona Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 490, 55 S. Ct. 455, 79 L. Ed. 1005."

The above decisions clearly support Petitioner in submitting that the disclaimers in the instant case are not in conflict with the principle announced by this Court in the *Altoona* case, and that the lower courts were erroneous in holding that Claims 6 and 7 of the Holdsworth patent were rendered invalid by the disclaimer for the reasons (a) that the disclaimer does not add a new element to the wall construction defined in original Claims 6 and 7, and (b) does not transform the Holdsworth patent originally for one combination "into a new and different one" for a new combination.

3.

Prior to the judgment of the Court of Appeals for the Second Circuit in the instant case, the disclaimer statute never has been limited to the elimination of entire claims, but disclaimers repeatedly have been sustained as valid which so restricted broad claims as to exclude that of which the patentee was not the inventor.

The judgment of the lower courts in the case at bar that Petitioner should be deprived of protection for the invention covered by Claims 6 and 7 because the disclaimer "limiting the claim to a specific type of the general class to which it was applied" is inconsistent with the purpose and intent of the patent statutes, namely, to benefit the public by encouraging the making of inventions through securing to inventors for limited terms the exclusive rights to their inventions.

Prior to 1832 an inventor's patent was invalid if through inadvertence, accident or mistake, without fraudulent intention, he had either failed to adequately claim his invention or had claimed more than that of which he was the inventor. Therefore, prior to 1832 the patent law failed in its intended purpose in that it discouraged the making of inventions by holding that an inventor should be deprived of his patent, although it disclosed a practical and useful invention, if he had in good faith either failed to adequately protect his invention or claimed more than that of which he was the inventor.

President John Quincy Adams, in his first annual message to Congress on December 6, 1825, expressed apprehension lest the then existing laws did not insure to inventors an adequate reward. He said:

> "If an honest pride might be indulged in the reflection that on the records of the (Patent) Office are already found inventions, the usefulness of which has scarcely been transcended in the annal of human endeavor, would not its exaltation be allayed by inquiry whether the laws have effectively insured to the inventors the reward destined to them by the Constitution—even a limited term of exclusive right to their disclosures." (Messages and Papers of the Presidents, Vol. II, p. 315.)

Mr. Chief Justice Marshall in *Grant* v. *Raymond*, 31 U. S. 217 (1832), stated (pp. 240, 242):

> "It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received; if this can be done, without transcending the intention of the statute, or countenancing acts which are fraudulent, or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has con-

tracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it, during that time, the public faith is pledged."

. . . . . .

". . . The great object and intention of the act is, to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals, for the time and labor devoted to these discoveries, by the exclusive right to make, use and sell the things discovered, for a limited time."

Senator John Ruggles, Chairman of the Committee on Patents, stated in the United States Senate on January 9, 1837, shortly before the enactment of the Disclaimer Statute, as follows:

"Inventors are public benefactors, contributing to the promotion and improvement of all branches of national industry, and, in most instances, without any adequate remuneration."

The reissue statute of 1832 and 1835 was in harmony with the views expressed by President Adams and Chief Justice Marshall, and sought to render the patent laws more consistent with their purpose and intent, and it is not an unreasonable explanation of the enactment of the disclaimer statute in March, 1837, that Congress, in agreement with the views expressed by President Adams and by Chief Justice Marshall, further amended the patent laws to afford more adequate protection to the inventor who had in good faith disclosed his invention to the public by permitting him to maintain his patent for that which he had invented by disclaiming that which he had mistakenly claimed.

The Court of Appeals in the instant case is inconsistent with the obvious purpose and intent of the disclaimer statute in holding that an inventor forfeits his right to protection for an invention made by him if he surrenders

something inadvertently claimed in his patent by specifying, through a disclaimer, that a certain element in his claim possesses certain characteristics. The Court of Appeals held that the disclaimer statute permits only the disclaiming of a complete claim, and does not permit rendering a generic claim more specific. The Court of Appeals said:

> ". . . Every such disclaimer, *i.e.*, every one which does not surrender the whole claim, must 'add a new element' to be a disclaimer at all; it must declare that the claim shall cover no longer a part of those objects which it formerly did cover, and it can do this in no other way than by adding a new element to the claim" (R. 111).

> "It must, however, be admitted that before *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, the law, as settled by the lower courts (ourselves included) was otherwise, although, so far as we have found, the Supreme Court had never before discussed the question and sustained such a disclaimer against the objections we have stated; not even in *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 435, 436, which has been often cited as doing so" (R. 112).

A careful review of the decisions of this Court relating to disclaimers fails to disclose a single instance in which it has been held that the disclaimer statute can only be availed of through the cancellation of a complete claim, and does not permit a patentee to surrender that which he had inadvertently claimed, by specifying that an element originally in a claim possesses certain structural characteristics.

On the other hand, this Court has frequently sustained disclaimers which did not eliminate entire claims but limited claims already in the patent so as to exclude that which the patentee had not invented, and maintained his patent for that which he had invented.

In 1857 this Court in *Silsby et al.* v. *Foote*, 61 U. S. 378, 379, sustained a disclaimer which limited a claim in the patent so as to more specifically define the invention. The original claim was as follows:

> "What I claim as my invention, and desire to secure by letters patent, is the application of the expansive and contracting power of a metallic rod by different degrees of heat to open and close a damper, which governs the admission of air into a stove or other structure in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue, . . ."

The disclaimer stated that the patentee had reason to believe that through inadvertence and mistake the quoted claim was too broad, including that of which the patentee was not the first inventor. The following disclaimer was therefore made:

> "Your petitioner, therefore, hereby enters his disclaimer to so much of said claim as extends the application of the expansive and contracting power of a metallic rod by different degrees of heat to any other use or purpose than that of regulating the heat of a stove, in which such rod shall be acted upon directly by the heat of the stove, or the fire which it contains; . . ."

This Court explained the act of March 3, 1837, and held that the disclaimer was within the purview thereof. Mr. Justice Grier, in a dissenting opinion, compared as follows the reissue and disclaimer statutes (p. 388):

> ". . . The patent act of 1836, section 13, provides a remedy, 'where a patent is inoperative and void, by reason of a patentee's claiming in his specification as his invention more than he had a right to claim,' and when the error has arisen through inadvertence or mistake.'
>
> "In such a case, the patentee is permitted to surrender his patent, and, on payment of a further sum, have his patent reissued as corrected. But he was not permitted to recover any damage for infringe-

ment which occurred before the date of the reissued patent.

"The patent act of 1837, section 7, gives a further privilege to the patentee of escaping the consequences of such a defect, 'where his patent is too broad,' by permitting him to enter a disclaimer, to be taken and considered as part of the original specification. It does not subject him to the costs of a new patent, nor to the forfeiture of antecedent damages, where the disclaimer is made during the pendency of a suit, but gives the defendant a right to object to its validity on account of unreasonable neglect and delay in filing it."

This Court in *Cartridge Co.* v. *Cartridge Co.*, 112 U. S. 624, favorably considered a disclaimer, which had been filed pursuant to a requirement of the Patent Office as a condition to obtaining an extension of the patent, the nature of which appears from the following quotation from the opinion of this Court (p. 643):

". . . The effect of the disclaimer was to limit the claims of the reissue to a machine with the stationary die E, shown in the original patent and drawings, and to prevent their any longer covering, even if they had before covered, a movable die E, or bunter."

The Court made the following statement regarding the scope and effect of a disclaimer made pursuant to the Act of March 3, 1837 (p. 642):

"It is a patentee who 'has claimed more than that of which he was the original or first inventor or discoverer,' and only 'such patentee,' or his assigns, who can make a disclaimer; and the disclaimer can be a disclaimer only 'of such parts of the thing patented as he shall not choose to claim or hold by virtue of the patent or assignment.' A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a claim in respect to the thing so not originally or first invented. It is true, that, in so disclaiming or limiting a claim, descriptive matter on which the disclaimed claim is based, may,

as incidental, be erased, in aid of, or as ancillary to, the disclaimer. But the statute expressly limits a disclaimer to a rejection of something before claimed as new or as invented, when it was not new or invented, and which the patentee or his assignee no longer chooses to claim or hold. It is true, that this same end may be reached by a reissue, when the patentee has claimed as his own invention more than he had a right to claim as new, but, if a claim is not to be rejected or limited, but there is merely 'a defective or insufficient specification,' that is, description, as distinguished from a claim, the only mode of correcting it was and is by a reissue."

It will be observed that this Court approved of a disclaimer which did not cancel an entire claim but limited claims of a reissue patent, and expressly referred to a disclaimer applying "when it is intended to limit a claim."

This Court in *Hurlbut* v. *Schillinger*, 130 U. S. 456, 465, sustained a disclaimer which limited the scope of the patent without wholly eliminating a claim. This Court said:

"We are of opinion that the proper construction of the reissued patent is, that the invention consists in dividing the pavement into blocks, so that one block can be removed and repaired without injury to the rest of the pavement, the division being effected by either a permanent or a temporary interposition of something between the blocks. Concrete pavement had been laid before in sections, without being divided into blocks. The effect of the disclaimer was to leave the patent to be one for a pavement wherein the blocks are formed by interposing some separating material between them. To limit the patent to the permanent interposition of a material equivalent to tar-paper, would limit the actual invention." . . . "The disclaimer took out of the first claim of the reissue only so much thereof as claimed a concrete pavement made of the plastic material laid in detached blocks, without interposing anything in the joints in the process of formation, leaving that claim to be one for such a pavement laid in detached blocks, when free joints are made between the blocks, by interposing perma-

nently or temporarily between them, in the process of their formation, tar-paper or its equivalent."

This Court in a more recent decision in *Minerals Separation* v. *Butte & Superior Mining Co.*, 250 U. S. 336, sustained a disclaimer which did not remove any entire claim from the patent but limited some claims by specifying characteristics of the elements so as to make them less generic. One of the claims of the patent in suit, No. 835,120, to which a disclaimer was made, read as follows:

> "9. The process of concentrating powdered ores which consists in separating the mineral from gangue by coating the mineral with oil in water containing a small quantity of oil, agitating the mixture to form a froth, and separating the froth." (125 O. G. 127.)

The disclaimer (237 O. G. 311) to Claim 9, as well as Claims 10 and 11, was as follows:

> "Any process of concentrating powdered ores excepting where the results obtained are the results obtained by the use of oil in a quantity amounting to a fraction of one per cent. on the ore."

This Court said (p. 354):

> ". . . While the wording of the disclaimer borders on finesse, we do not think it can be interpreted as giving any rights under the patent greater than may be legitimately obtained under the claims held valid, and we therefore deem it sufficient to meet the requirements of the statutes cited."

The decisions of Circuit Courts of Appeals and of District Courts sustaining as valid disclaimers which did not eliminate entire claims but did limited claims so as to render them more specific and thereby surrender an invention inadvertently claimed, are too numerous to review in detail. As illustrations of such decisions of Courts of Appeals are those of the Third Circuit in *Seiberling* v. *John E. Thropp's Sons*, 284 Fed. 746; the more recent decisions hereinabove referred to by the Sixth Circuit Court of Ap-

peals in *Byrne Mfg. Co.* v. *American Flange & Mfg. Co.*, 87 F. (2d) 783, and in *Cincinnati Rubber Mfg. Co.* v. *Stowe-Woodward, Inc.*, 111 F. (2d) 239; by the Seventh Circuit in *Johnson Laboratories* v. *Meissner Mfg. Co.*, 98 F. (2d) 928, and the Ninth Circuit Court of Appeals in *Payne Furnace & Supply Co.* v. *Williams-Wallace Co.*, 117 F. (2d) 823.

As illustrations of decisions of the District Courts to the same effect, reference may be made to that of Judge Hazel in *Page Mach. Co.* v. *Dow, Jones & Co.*, 200 Fed. 72; Judge Schoonmaker in *American Morgan Co.* v. *Joy Mfg. Co.*, 31 F. Supp. 419, 424, and Judge Chestnut in *Kilgore Mfg. Co.* v. *Triumph*, 37 F. Supp. 766, 770.

It therefore is submitted on behalf of Petitioner that the Court of Appeals for the Second Circuit in holding that the disclaimer statute permits only the elimination of complete claims, and that a patentee who limits a claim by specifying that an element thereof has certain structural characteristics renders his patent invalid, is inconsistent with the obvious purpose and intent of the disclaimer statute, and contrary to numerous decisions of this and lower Federal courts.

4.

Stare decisis. The judgment of the Court of Appeals for the Second Circuit will destroy property rights in hundreds of patents now in force which have been restricted by disclaimers made in good faith pursuant to an interpretation which has existed more than a hundred years of the disclaimer statute.

The Official Gazette of the United States Patent Office publishes weekly the disclaimers which have been filed pursuant to the disclaimer statute. Disclaimers have been filed in several hundred patents still in force which have not renounced entire claims but have so limited certain

claims as to exclude inventions inadvertently included in them, and thereby preserve the validity of the patents for the inventions actually made by patentees.

The decision of the Court of Appeals for the Second Circuit in the instant case, if not corrected by this Court, in effect invalidates hundreds of patents in which the patentees, in good faith, have filed disclaimers in accordance with the disclaimer statutes as interpreted for more than one hundred years. The property of patentees in the patents in which such disclaimers have been filed will be destroyed.

If the Court of Appeals in the instant case is correct in interpreting the disclaimer statutes differently from the interpretation which has existed for more than one hundred years, a situation is presented to which the law of *stare decisis* is strikingly applicable.

This Court in *Pollock* v. *Farmers' Loan & Trust Co.*, 157 U. S. 429, 574, said:

> "Doubtless the doctrine of *stare decisis* is a salutary one, and to be adhered to on all proper occasions, but it only arises in respect of decisions directly upon the points in issue."

The decisions which during more than one hundred years have construed the disclaimer statute so as to permit a patentee who has in good faith, though erroneously, presented claims broader than his invention, to so limit the claims as to exclude that which he had not invented and to preserve his protection for his own invention, are "decisions directly upon the points in issue." The long prevailing interpretation of the disclaimer statute does not injure the public, but in effect benefits it not only through encouraging the making of invention by treating fairly and liberally patentees, but also by keeping faith with inventors who, relying upon promised protection, have disclosed to the public their inventions so that they may be

freely available to the public upon the expiration of the patents. As well stated by Chief Justice Marshall: "The public faith is pledged to the inventor."

In *Bouvier's Law Dictionary*, Vol. 2, page 3119, the following pertinent statement regarding *stare decisis* occurs:

> ". . . Where there have been a series of decisions by the supreme judicial tribunal of a state, the rule of *stare decisis* may usually be regarded as impregnable, except by legislative act; *Harrow* v. *Myers*, 29 Ind. 470. Especially is this the case where the law has become settled as a rule of property, and titles have become vested on the strength of it; *Reed* v. *Ownby*, 44 Mo. 206; *Brown* v. *Finley*, 157 Ala. 424, 47 South. 577, 21 L. R. A. (N. S.) 679, 131 Am. St. Rep. 68, 16 Ann. Cas. 778; . . ."

The law of *stare decisis* of course only applies to erroneous decisions pursuant to which rights have accrued that it would be unjust to destroy, and is inapplicable where greater injury would be done by following an erroneous decision than by correcting it. In the instant case there have been no decisions contrary to the interpretation of the statute in question for which Petitioner contends, and if they are incorrect, which Petitioner submits is not the case, a correction of them would do immeasureable harm to patentees, and would be of no real benefit to the public.

Conclusion.

The primary object and purpose of the patent statutes to benefit the public by encouraging the making of inventions through securing to inventors for limited terms exclusive rights to their respective inventions, are certainly not subserved by the judgment in the instant case, which destroys the property right of an inventor in his patent when he seeks to restrict it to that which he invented by

eliminating that which he erroneously, but in good faith, claimed.

It is submitted on behalf of Petitioner that its property right in its Holdsworth patent, and the property rights of hundreds of other owners of patents in which similar disclaimers have been filed should not be destroyed, and that the judgment of the Court of Appeals for the Second Circuit therefore should be reversed.

Respectfully,

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February 9, 1942.

APPENDIX.

Disclaimer Statutes.

U. S. Rev. Stat. Sec. 4917; U. S. C. Title 35, Sec. 65:

"Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it."

U. S. Rev. Stat. Sec. 4922; U. S. C. Title 35, Sec. 71:

"Suit for infringement where specification too broad.

"Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part

of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer."